

REMARKS/ARGUMENTS

Status of the Claims

Claims 20-28 are pending in the above-referenced patent application and are currently under examination. With entry of the present Amendment, independent claim 20 has been amended to correct the minor informalities noted by the Examiner in the Office Action. Such amendments relate to formal matter and, thus, no new matter is introduced.

Objection to Claim 27

In the Office Action, the Examiner objected to claim 27, stating that it exists in duplicate.

In the previously filed Amendment, claim 27 was duplicated in the listing of the claims. Applicants have corrected the listing of the claims so that claim 27 is only set forth once. Accordingly, Applicants urge the Examiner to withdraw this objection.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 20-28 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In making this rejection, the Examiner has stated that (1) the phrase “general formulae” in claim 20 is indefinite; and (2) that the substituent “R₁” in claim 20 lacks proper antecedent basis.

In order to expedite prosecution, Applicants have amended claim 20 (1) to replace the phrase “general formulae” with the phrase “formulae,” and (2) to replace the substituent “R₁” with the proper substituent “R¹.” In view of the amendments to claim 20, the Examiner’s concerns have been overcome. Accordingly, Applicants urge the Examiner to withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 102(e) or, alternatively, Under 35 U.S.C. § 103(a) Over Hargis

Claims 20-26 and 28 remain rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Hargis (U.S. Patent No. 5,674,951). In addition, claim 27 remains rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Hargis or, in the alternative, under 35 U.S.C. §

103(a) as allegedly being obvious over Hargis in view of the Examiner's Notice. In maintaining this rejection, the Examiner has indicated that the previously filed Declaration of Drs. Malik and Archibald, which was filed pursuant to 37 C.F.R. § 1.131, is insufficient because it does not contain documented evidence of conception and reduction to practice of the claimed invention prior to the priority date of the Hargis patent, *i.e.*, the '951 patent.

In response, Applicants respectfully submit that the previously filed declaration establishes that to the extent the presently claimed invention is disclosed, but not claimed in the Hargis patent, it is derived from a named inventor of the above-referenced patent application and, thus, the disclosure of the invention is not "by another." In fact, in their declaration, Drs. Malik and Archibald attest to the fact that "[t]o the extent the '951 patent discloses fluorinated oxetane ("FOX") monomers, FOX prepolymers and co-prepolymers and the presently claimed fluorinated polyurethane elastomers, ***this is our work***" (*see*, page 3 of the Declaration of Drs. Malik and Archibald (emphasis added)). Again, Dr. Malik is named as an inventor on the Hargis patent, but to the extent the Hargis patent discloses (but does not claim) the presently claimed fluorinated polyurethane elastomers, Drs. Malik and Archibald declare that this is their work and, thus, not work of another.

As such, in view of the previous filing of the Declaration of Drs. Malik and Archibald, the Examiner's rejection is rendered moot. Accordingly, Applicants urge the Examiner to withdraw the rejection.

Appl. No. 09/520,476
Amdt. dated August 27, 2004
Reply to Office Action of February 27, 2004

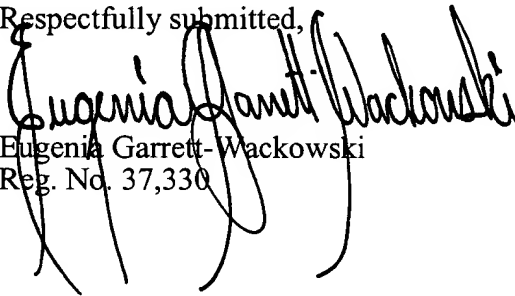
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eugenia Garrett-Wackowski". The signature is fluid and cursive, with the first name "Eugenia" being the most prominent.

Eugenia Garrett-Wackowski
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